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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,289	02/11/2004	David M. Hilbert	FX/A3003	5294
23910	7590	07/28/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			KIM, PAUL	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,289

Applicant(s)

HILBERT ET AL.

Examiner

Paul Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/9/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This Office action is responsive to the following communication: Original application filed on 11 February 2004.
2. Claims 1-38 are pending and present for examination. Claims 1, 8, 15, 22, 26, and 32 are independent.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 9 February 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- Figure 6, Reference characters 610 and 630.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-6, 8-13, 15-20, 22-35, and 38** rejected under 35 U.S.C. 102(e) as being anticipated by Hilbert et al (USPGPUB 2003/0088580, hereinafter referred to as HILBERT), filed on 5 November 2001, and published on 8 May 2003.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. **As per independent claims 1, 15, 26, and 32**, HILBERT teaches:

A method for providing access to remotely stored files, the method comprising:

receiving an identifier from a user {See HILBERT, Para. 0063, wherein this reads over "inputting an identity of a user into a device portal of the multi-user document device"};

contacting at least one file source associated with the identifier {See HILBERT, Para. 0033, wherein this reads over "using the user identification device to verify the user of a multi-user document device and accessing a personal portal associated with the user based on the verified identity of the user"; and Para. 0063, wherein this reads over "associating the identity of the user with a user identification device"}; and

generating a list of at least one recently accessed file from the file source {See HILBERT, Para. 0071, wherein this reads over "the personal resources may include various informational resources such as . . . recent documents"}.

8. **As per dependent claim 2**, HILBERT teaches:

The method of claim 1, further comprising presenting the user with an option of printing the file {See HILBERT, Para. 0106, wherein this reads over "whether or not the user has selected a print

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function of the multi-user document device. If so, control continues to step S8350 where a personal print interface is generated"}.

9. **As per dependent claim 3, 23, 28, and 34, HILBERT teaches:**

The method of claim 1, further comprising retrieving the file from the file source {See HILBERT, Para. 0103, wherein this reads over "a determination is made whether or not the user has selected a file. If so, control continues to step S8300 where a personal file interface is generated"}.

10. **As per dependent claims 4, 11, 18, 25, and 29, HILBERT teaches:**

The method of claim 1, wherein generating the list of at least one recently accessed file comprises receiving a list of at least one recently accessed file on the file source {See HILBERT, Para. 0102, wherein this reads over "access a database of personal resources, such as recent document files"}.

11. **As per dependent claims 5, 12, 19, HILBERT teaches:**

The method of claim 1, wherein generating the list of at least one recently accessed file comprises:

reading a time of last access for files stored on the file source {See HILBERT, Para. 0102, wherein this reads over "access a database of personal resources, such as recent document files"}; and

selecting a file according to its time of last access {See HILBERT, Para. 0103, wherein this reads over "a determination is made whether or not the user has selected a file"}.

12. **As per dependent claim 6, 13, 20, 30, and 35, HILBERT teaches:**

The method of claim 1, wherein generating the list of at least one recently accessed file comprises:

determining an application available to the user {See HILBERT, Para. 0102, wherein this reads over "the username, password and/or profile is used to access a database or personal resources, such as recent document files and email"}; and

receiving from the file source a list of at least one file associated with the application {See HILBERT, Figure 7; and Para. 0079, wherein this reads over "the personal resources accessible via the personal portal may include previous interaction history, such as facsimile call logs"}.

13. **As per independent claim 8, HILBERT teaches:**

A system for providing access to remotely stored files, the system comprising:

a client interface configured to receive an identifier from a user {See HILBERT, See Figures 1-3; and Para. 0074, wherein this reads over "[a] user identification device is used to identify the user to the interface. In various embodiments, the user identification device may be a key entry associated with the user"}; and

a file selection generator configured to:

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contact at least one file source associated with the identifier {See HILBERT, Para. 0079, wherein this reads over "the personal portal may include access to the various information resources provided by the device portal as well as personal resources such as documents/desktop resources, email and other information"}; and

generate a list of at least one recently accessed file from the file source {See HILBERT, Para. 0079, wherein this reads over "the personal portal may include previous interaction history, such as facsimile call logs"}.

14. As per dependent claims 9 and 33, HILBERT teaches:

The system of claim 8, wherein the client interface is further configured to present the user with an option to view the file {See HILBERT, Figures 9-12}.

15. As per dependent claims 10 and 17, HILBERT teaches:

The system of claim 9, wherein the list of recently accessed files comprises a list of most recently created files {See HILBERT, Para. 0102, wherein this reads over "access a database of personal resources, such as recent document files"}.

16. As per dependent claim 16, HILBERT teaches:

The computer program product of claim 15, wherein the computer code instructions further comprise providing the user with an option of transferring the file to a system of the user or to another location {See HILBERT, Para. 0106, wherein this reads over "[t]he user may then operate the multi-user document device via the personal portal using the file" and "a determination is made whether or not the user has selected an e-mail function"}.

17. As per independent claim 22, HILBERT teaches:

A system for providing access to files, the system comprising:

a file server storing files and a list of at least one recently accessed file {See HILBERT, Para. 0028, wherein this reads over "a portal server that generates a device portal based on at least one of any identity of a user"}; and

an access server configured to:

receive an identifier from a user {See HILBERT, Para. 0063, wherein this reads over "inputting an identity of a user into a device portal of the multi-user document device"};

contact the file server in response to receiving the identifier {See HILBERT, Para. 0079, wherein this reads over "the personal portal may include access to the various information resources provided by the device portal as well as personal resources such as documents/desktop resources, email and other information"}; and

retrieve the list of at least one recently accessed file from the file server {See HILBERT, Para. 0079, wherein this reads over "the personal portal may include previous interaction history, such as facsimile call logs"}.

18. As per dependent claim 24, HILBERT teaches:

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The system of claim 22, wherein the access server is further configured to provide the user with an option of emailing the file to another location {See HILBERT, Para. 0081, wherein this reads over "[t]he personal portal may enable a unique interface for messaging such as e-mail communication"; and Para. 0106, wherein this reads over " a determination is made whether or not the user has selected an e-mail function of the multi-user document device"}.

19. **As per dependent claim 27**, HILBERT teaches:

The method of claim 26, further comprising presenting the user with an option of faxing a file in the unified list {See HILBERT, Para 0103, wherein this reads over "the user has selected a fax function of the multi-user document device"; and Para. 0120, wherein this reads over "the faxed file is added to a recent file list to update the personal portal"}.

20. **As per dependent claims 31 and 38**, HILBERT teaches:

The method of claim 25, further comprising presenting to the user a startup screen which includes a visual display representing the list of recently accessed files {See HILBERT, Figures 9-12}.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claims 7, 14, 21, 36, and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over HILBERT, in view of Godlin et al (USPGPUB 2002/0161860, hereinafter referred to as GODLIN), filed on 31 October 2001, and published on 31 October 2002.

HILBERT teaches the limitations of claims CCCC for the reasons stated above.

HILBERT differs from the claimed invention in that HILBERT fails to specifically disclose a method of receiving changes to a copy of the file and transmitting the copy of the file to the file source (claims 7, 14, 21, 36, and 37).

23. **As per dependent claims 7, 14, 21, 36, and 37**, HILBERT, in combination with GODLIN teaches:

The method of claim 1, further comprising:

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receiving changes to a copy of the file {See GODLIN, Para. 0147, wherein this reads over "[i]f the latest version is in the cache, the client will utilize the version stored in the cache. If there is a more recent version on the server, in step 446 the server sends and the client receives the delta ('diff') between the latest version, and the version that the client has cached"}; and

transmitting the copy of the file to the file source {See GODLIN, Para. 0147, wherein this reads over "[t]he client then reconstructs the latest version of the requested file in step 448. The client applies the diff pairs to the cached version serially and updates the vnum to the latest version"}.

The combination of inventions disclosed in HILBERT and GODLIN would disclose a method where changes to a copy of the file (e.g. the delta between the latest version and the version that the client has cached) are received, and the copy of the file transmitted to the file source (e.g. the client). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by HILBERT with GODLIN.

One of ordinary skill in the art would have been motivated to do this modification so that where changes are made to a file, the modified copy of the file is transmitted to the file source.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**SAM RIMELL
PRIMARY EXAMINER**

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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